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| APPLICATION NO.                                                                                             | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO.       |
|-------------------------------------------------------------------------------------------------------------|-------------|----------------------|-------------------------------|------------------------|
| 10/815,769                                                                                                  | 04/02/2004  | Daisuke Yahata       | 360842009710                  | 9944                   |
| 7590 04/26/2010                                                                                             |             |                      |                               |                        |
| Barry E. Bretschneider<br>Morrison & Foerster LLP<br>Suite 300<br>1650 Tysons Boulevard<br>McLean, VA 22102 |             |                      | EXAMINER<br>JUSKA, CHERYL ANN |                        |
|                                                                                                             |             |                      | ART UNIT<br>1786              | PAPER NUMBER           |
|                                                                                                             |             |                      | MAIL DATE<br>04/26/2010       | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/815,769

**Applicant(s)**

YAHATA ET AL.

**Examiner**

Cheryl Juska

**Art Unit**

1786

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-24, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-24, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date 02/16/10
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's amendment filed January 25, 2010 has been entered. Claim 22 has been amended as requested. Claims 1-21 and 25-29 have been cancelled and new claims 30 and 31 have been added. Thus, the pending claims are 22-24, 30, and 31.
2. Applicant's arguments regarding the 102 rejection of claims 22-24 over the cited Matsunaga references (Amendment, paragraph spanning pages 3-4) have been found persuasive. Specifically, the anticipation rejection of the claims is hereby withdrawn since the Mito Declaration filed 02/13/2009 shows that yarns produced by a one-step process as disclosed by Matsunaga does not *necessarily* possess the presently claimed properties. However, the claims remain rejected under 35 USC 103 as set forth below.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 22-24 stand rejected under 35 U.S.C. 103(a) as obvious over WO 00/65140 issued to Matsunaga et al. as set forth in section 3 of the last Office Action (Non-Final Rejection mailed 12/24/2009).

Claims 22-24 stand rejected under 35 U.S.C. 103(a) as obvious over US 2003/0152743 issued to Matsunaga et al. as set forth in section 4 of the last Office Action. [Note US 2003/0152743 is the English language equivalent of the Japanese language WO 00/65140.]

As noted above, the 102 rejection of claims 22-24 by the Matsunaga references is withdrawn. However, the 103 rejections stand. While the Mito Declaration shows that the one-step process of Matsunaga does not necessarily produce the presently claimed properties, applicant's own specification establishes said one-step process can produce carpet yarns with similar properties. Specifically, Example 12 and Comparative Example 3 have properties either within the ranges claimed or just outside of said claimed ranges. Note the crimp elongation rate of 5.0 disclosed in Comparative Example 3 is very close to the claimed rate of 5.2. Similarly, the breaking strength of the 1.2 disclosed in Example 12 is very close to the claimed 1.4 breaking strength. The values are so close that one skilled in the art would expect like behaviors from the yarns. See *Titanium Metals Corp. v. Banner*, 227 USPQ 773, 779. As such, absent a showing of criticality from applicant, the present claims stand obvious over the cited prior art. *In re Woodruff*, 16 USPQ2d 1934 states, "The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims....In such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range." Thus, the claims stand rejected as being obvious over the prior art.

5. Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as obvious over WO 00/65140 issued to Matsunaga et al.

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as obvious over US 2003/0152743 issued to Matsunaga et al.

New claims 30 and 31 limit the aliphatic polyester of claim 22 to having a refractive index of 1.5 or less and 1.45 or less, respectively. The new claims are also rejected by the cited prior art since the Matsunaga references clearly teach aliphatic polyester compositions like those disclosed by applicant, especially polylactic acid polyesters comprising L-lactic acid. See Matsunaga '743, sections [0014] and [0015]. As such, it is reasonable to presume the polylactic acid polyester of the prior art has refractive index within the range claimed. Like materials cannot have mutually exclusive properties. Hence, claims 30 and 31 are also rejected as being obvious over the prior art.

### ***Response to Arguments***

6. Applicant's arguments with respect to the patentable weight of the claimed two step drawing process (Amendment, paragraph spanning pages 4-5) have been fully considered but they are not persuasive. As previously argued, applicant's own working examples presented in the specification show that a one-step process can be employed produce yarns possessing like properties. This conflicting evidence suggests that there are other factors dependent upon producing the claimed yarn properties other than merely recited two-step process. While the data of said Declaration is not disputed, it does not establish significant differences are obtained by one process over another. In other words, a change in a process variable is expected to produce a slight change in the product. However, it is not clear said process should be given

patentable weight, since the specification evidences said difference in properties is not necessarily due to the difference in said process variable. Once again, note Example 12 and Comparative Example 3, which produce yarns having properties similar to those claimed by a one-step process like that disclosed in the prior art. Therefore, applicant's arguments are found unpersuasive and the above rejections stand.

### *Conclusion*

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
8. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the

examiner by telephone are unsuccessful, the examiner can be emailed at [cheryl.juska@uspto.gov](mailto:cheryl.juska@uspto.gov) or the examiner's supervisor, D. Lawrence Tarazano can be reached at 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Cheryl Juska/*  
Primary Examiner  
Art Unit 1794